

Atty. Dkt. No. 035451-0119 (3597.Palm.SG)

**REMARKS**

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

Claims 12 and 19 are requested to be cancelled without prejudice.

Claims 1, 13, 21, and 35 are currently being amended.

This amendment adds, changes and/or deletes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claims remain under examination in the application, is presented, with an appropriate defined status identifier.

After amending the claims as set forth above, claims 1-4, 6, 9-11, 13, 15-18 and 20-39 are now pending in this application.

In section 4 of the Office Action, the Examiner rejected claims 1-4, 6, 9-10, 13, 15-16, 20-26, 28-30, and 35-39 under 35 U.S.C. § 103(a) over Schlack et al. (U.S. Patent No. 5,392,447) in view of Windows Operating System and Kobayashi (U.S. Patent No. 6,199,122). Applicants have amended independent claims 1, 13, 21, and 35 to recite in one form or another that the expansion card slots of the docking station or synchronization cradle are configured to not only accept memory cards but are also configured to accept rechargeable battery packs. Support for and description of the use of a synchronization cradle to accept rechargeable battery packs is provided at paragraphs [0021] and [0023] of Applicant's specification. Applicants respectfully submit that because the use of handheld computers or other portable electronic devices is heavily dependent on having portable power (i.e., a rechargeable battery pack), it is desirable to have extra or spare battery packs that may be recharged while the handheld computer is sitting in the docking cradle or out of the docking cradle. Many rechargeable battery packs are recharged while they remain in the portable electronic device or handheld computer and the handheld computer is placed in the docking cradle thereby making it impossible to charge the battery when the device is out of the cradle. Here, it is desirable in that a spare battery pack may

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be recharged while the handheld computer may be taken in and out of the synchronization cradle. Further, it is advantageous to utilize the slots or receptacles of the synchronization cradle which also accept the memory devices, thereby not requiring extra receptacles in the synchronization cradle and providing a cost savings in the manufacture and production of the synchronization cradle itself. Further, having more than one receptacle provides the opportunity for a user to recharge one battery pack while manipulating data on a memory device that resides in the other expansion slots or receptacles.

In section 5 of the Office Action, the Examiner rejected claims 11-12, 17-19, 27, and 31-34 under Schlack et al. and Kobayashi and Windows Operating System. The Examiner also relied on supplementary references including a card-type rechargeable battery pack described in the article: "*Personal Computer Menu Card International Association Compatible Battery and Charging Cards*", IBM Technical Disclosure Bulletin, September 1993, U.S. Vol. 36, Issue 9A, pp. 167-170. Applicants respectfully submit that although card type rechargeable battery packs are known, there is no teaching or disclosure or suggestion to combine the references in such a way as to provide a synchronization cradle that has two receptacles which are configured to receive both memory devices and rechargeable battery packs. The synchronization docking cradle is utilized with a handheld computer or other portable electronic device providing all of the advantages described above and in the specification. Accordingly, all of the limitations of the amended claims 1, 13, 21, and 35 are not taught, disclosed, or suggested alone, or in any combination of the references of Schlack et al. in view of Windows and Kobayashi and IBM Technical Disclosure. Further, the Examiner has not provided a motivation to combine all of these references to arrive at the combination of elements recited in Applicant's independent claims. There is no desirability provided by the references to make the combination of claim elements. Applicants have shown the advantages of the claimed combinations of elements. Most if not all inventions arise from a combination of old elements. See In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998). Thus, every element of a claimed invention may often be found in the prior art. See id. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention.

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See *id.* Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. See In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

Accordingly, Applicants respectfully submit that claims 1, 13, 21, and 35 and their respective dependent claims are allowable.

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 06-1447. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 06-1447. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. § 1.136 and authorizes payment of any such extensions fees to Deposit Account No. 06-1447.

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Respectfully submitted,

Date January 04, 2005

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